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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,502	11/13/2001	Masahiko Sato	450100-03617	3958
20999 7590 01/11/2008 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			EXAMINER SHANG, ANNAN Q	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 01/11/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/047,502

Applicant(s)

SATO ET AL.

Examiner

Annan Q. Shang

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-18,21-31,33-35 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-18,21-31,33-35 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/22/07 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 2, 4, 5, 7-18, 21-31, 33-35 and 37 have been considered but are moot in view of the new ground(s) of rejection.

With respect to claims 1-5, 7-8, 10, 14-19, 21-22, 24 and 28-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Shah-Nazaroff et al (6,157,377)** and the various 103(a) rejection of the last office action, applicant amends claims and argues that the prior arts of record do not teach the amended claim limitation (see page 12 of 15 of applicant's Remarks/Arguments).

In response, Examiner disagrees. Examiners notes applicant's arguments, however, Russo teaches the amended claim limitation, "...charging information means for storing in a memory the varied amount of fees that are charged and for reproducing and transmitting, subsequent to the unloading, the amount of fee that is charged for the information that is unloaded." (col.6, lines 34-53, line 63-col.7, line 23, col.9, line 51-

col.10, line 10 and line 39+). Russo stores different quality based upon input criteria, but silent to where the dubbing comprises status information transmitted for conversion prior to unloading. However, this deficiency is disclosed in **Shah-Nazaroff** reference, which discloses in figures 1-6, method and apparatus for purchasing upgraded media features for programming transmissions, transmits status information to the client prior to unloading and enables a user selected upgrade or quality of media, to be applied to the media before unloading (col.2, line 18-col.3, line 1+, col.4, line 16-col.5, line 1+ and col.6, lines 15-48). Hence the amended claims do not overcome the prior arts of record as discussed below. The amendments to the claims necessitated the new ground(s) of rejection. **This office action is non-final.**

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7, 8, 10, 14-18, 21-22, 24 and 28-31, 33-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Shah-Nazaroff et al (6,157,377)**.

As to claims 1, 2 and 4, note the **Russo** reference figures 1-2, discloses stored program pay-per-play and further discloses an information recording apparatus comprising:

Information recording means (Controller 'C' 10) for recording information in a first recording medium (Storage 'S' 14 or 110) and information storing means (figs.1, 2, col.3, line 40-col.4, line 27 and line 45-col.5, line 10);

Operation means (C-10) for operating unloading of the first recording medium the information recorded by the first recording means (col.4, line 45-col.5, line 10 and col.6, lines 33-53);

Unloading means (C-10) for unloading the first recording medium based on the operation of the operation means (col.4, line 45-col.5, line 10 and col.6, lines 33-53);
and

Fee charging means (C-10) for charging when the first recording medium is unloaded by the unloading means, and selecting means for selecting quality of the information to be stored in the first recording medium by the information recording means; where the fee charging means varies the amount of fee that is charged according to the quality selected by the selecting means and dubbing information stored in the first recording medium prior to the unloading and charging information means for storing in a memory the varied amount of fees that are charged and for reproducing and transmitting, subsequent to the unloading, the amount of fee that is charged for the information that is unloaded." (col.6, lines 34-53, line 63-col.7, line 23, col.9, line 51-col.10, lines 10-21 and line 39+).

Russo teaches storing different quality based upon input criteria, but silent to where the dubbing comprises status information transmitted for conversion prior to unloading.

However, note the **Shah-Nazaroff** reference figures 1-6, discloses method and apparatus for purchasing upgraded media features for programming transmissions, transmits status information to the client prior to unloading and enables a user selected upgrade or quality of media, to be applied to the media before unloading (col.2, line 18-col.3, line 1+, col.4, line 16-col.5, line 1+ and col.6, lines 15-48).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Shah-Nazaroff into the system of Russo to provide the user an opportunity to select affordable service based on image quality, sound or audio quality, etc.

As to claim 5, Russo further disclose notifying means for notifying charging of fee when unloading operation is performed through the operating means (col.4, line 45-col.5, line 10 and col.6, lines 33-53).

Claims 7-8, 10 and 14 are met as previously discussed with respect to claim 1.

As to claim 15-18, the claimed "A charging method for charging a fee related to an information recording..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-2.

Claims 21-22, 24 and 28 are met as previously discussed with respect to claim 1.

As to claims 29-31, the claimed "An information recording apparatus comprising..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claims 33-35, the claimed "A charging method for charging a fee related to an information recording apparatus..." is composed of the same structural elements that were discussed with respect to the rejection of claims 1-3.

As to claim 37, Russo further discloses where the charge information means stores a prepaid fee in the memory, the prepaid fee being reduced as the fee charging means charges the fee; the fee charging means charges the fee until the prepaid fee is exhausted, whereupon the unloading means no longer unloads the first recording medium (col.4, line 45-col.5, line 10, lines 48-65, col.6, lines 33-53 and col.10, lines 10+).

5. Claims 9, 11 and 23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Shah-Nazaroff et al (6,157,377)** as applied to claims 1 and 15 above, and further in view of **Hershtik et al (5,790,236)**.

As to claims 9 and 11, Russo as modified by Shah-Nazaroff, fail to explicitly teach where the quality of the information is based on number of languages and region code.

However, **Hershtik** teaches processing movies based on frame characteristics of the language and audio format, such as French, German, Italian, English, etc., all of which includes its region code (col.4, lines 50-65, col.6, line 61-col.7, line 55 and col.14, lines 31-67).

Therefore it would have obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching Hershtik into the system of Russo as modified

by Shah-Nazaroff in order to process image quality based on the language, audio and region code as selected by a user, to enable the information provider to meet various user preferences and charge a fee accordingly for these services.

Claims 23 and 25 are met as previously discussed with respect to claims 9 and 11.

6. Claims 12-13 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Shah-Nazaroff et al (6,157,377)** as applied to claims 1 and 15 above, and further in view of **Eyer et al (6,588,015)**.

As to claim 12-13, Russo as modified by Shah-Nazaroff, fail to explicitly teach selecting to recording of commercial message along with the information, where reducing the amount of charge when recording of the commercial message is selected.

However, note the **Eyer** reference, discloses various methods of reducing fees based on a user specific preferences related to commercials or ads (col.6, lines 50-61 and col.16, line 28-col.17, line 1+).

Therefore it would have obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Eyer into the system of Russo as modified by Shah-Nazaroff to enable a user to select desirable and affordable service and for the information provide to charge an appropriate fee based on the user's preference.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Murphy discloses system and method for sending live video on the Internet.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC)** at **866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA)** or **571-272-1000**.

A handwritten signature in black ink, appearing to read 'Annan Q. Shang', with a stylized flourish at the end.

Annan Q. Shang